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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,177	11/06/2001	Yutaka Imamura	81784.0245	9054
26021	7590	12/29/2004	EXAMINER	
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611			AGUSTIN, PETER VINCENT	
		ART UNIT	PAPER NUMBER	
		2652		

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/040,177	IMAMURA ET AL.
	Examiner Peter Vincent Agustin	Art Unit 2652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 October 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 3-8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyata (US 6,052,347) in view of Lee et al. (hereafter Lee) (US 6,404,712) or Kim (US 6,646,965).

Miyata discloses a laser output circuit for an optical disk recording apparatus (figures 11 & 12) in which an optical disk (1) is rotated at a constant angular speed (column 2, lines 19-22) and a signal is recorded while the disk is rotated, said laser output circuit comprising: a pickup control circuit (37) for controlling a pickup (35) position at which data is written onto the optical disk; a signal recording circuit (43) for supplying to said pickup data to be written onto said optical disk; a signal level detection circuit (41) for detecting a signal level of the signal read by said pickup; and a laser output setting circuit (45 & 47) for setting a laser output for the writing of data onto the optical disk by said pickup, wherein test data is written onto a trial writing region (figure 6, element 11) on an inner peripheral side of said optical disk and onto an outer peripheral region (15) outside a data writing region (13), the thus written test data is read from the disk, and said laser output is set in accordance with the signal levels of the test data read from both the trial writing region and the outer peripheral region (column 6, lines 18-29); and wherein said trial writing region (11), a program region (13), and an outer peripheral region (15) disposed in order from the inner peripheral side of said optical disk toward the outer peripheral side.

Miyata, however, does not disclose the presence of a buffer region, a lead-in region, and a lead-out region.

Lee discloses in figure 4 (or Kim in figure 4A) a trial writing region (PCA), a buffer region (PMA), a lead-in region (lead-in area), a program region (program area), and a lead out region (lead-out area) disposed in order from the inner peripheral side toward the outer peripheral side. It would have been obvious to one of ordinary skill in the art at the time of invention by the applicant to have added the trial, buffer, lead-in, program, and lead-out regions of Lee (or Kim) to the disk of Miyata, the motivation being to provide a more accurate test-writing.

3. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyata & Lee (or Kim) as applied to claim 1 above, and further in view of Den Boef (US 6,134,209).

For a description of Miyata & Lee (or Kim), see the rejection above. Furthermore, in regard to claim 3, Miyata discloses that the laser output setting circuit sets the laser output based on an inner peripheral side laser output (figure 13, step 63) set according to the test data read from the trial writing region, an outer peripheral side laser output set according to the test data read from the outer peripheral region (figure 13, step 67) (see also column 8, line 62 thru column 9, line 12). Furthermore, in regard to claim 4, Miyata discloses that said test data is written by altering the laser output within a predetermined range (column 6, lines 18-40). Miyata, however, does not disclose setting the laser output based on an information on a recording property of the disk (claim 3), where said recording property is determined from the test data based on a relationship between the laser output and the signal level of the signal read by said pickup (claim

4), and prerecorded data regarding a recording property of the disk is read from the disk, and said recording property is determined based on the read data (claim 5).

Den Boef discloses setting a laser output based on information on a recording property of a disk (column 2, lines 35-48), wherein said recording property is determined from test data based on a relationship between the laser output and the signal level of a signal read by a pickup (column 1, lines 56-59), and wherein prerecorded data regarding a recording property of the disk is read from the disk, and said recording property is determined based on the read data (column 1, lines 56-59). It would have been obvious to one of ordinary skill in the art at the time of invention by the applicant to have set the laser output of Miyata & Lee (or Kim) based on the recording property of a disk as suggested by Den Boef, the motivation being to provide a reliable method for setting the optimum write power depending on read signals from test patterns written on a medium and being less affected by noise (see column 1, lines 56-59).

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyata & Lee (or Kim) as applied to claim 1 above, and further in view of Horiguchi (US 5,321,679).

For a description of Miyata & Lee (or Kim), see the rejection above. However, in regard to claim 6, Miyata & Lee (or Kim) are silent to whether an inner peripheral side laser output set from the test data read from the trial writing region, and an outer peripheral side laser output set from the test data read from the outer peripheral region are stored in a memory.

Horiguchi discloses storing a laser output power in a memory (see abstract lines 8-11). It would have been obvious to one of ordinary skill in the art at the time of invention by the applicant to have stored the inner and outer peripheral side laser outputs of Miyata & Lee (or

Kim) to the memory of Horiguchi, the motivation being to obtain optimum operational conditions even when the optical pickup unit is exchanged (see abstract lines 4-6).

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyata, Lee (or Kim) & Horiguchi as applied to claim 6 above, and further in view of Inaba (JP 58164059 A).

For a description of Miyata, Lee (or Kim) & Horiguchi, see the rejection above. However, it is not disclosed that the inner peripheral side laser output set according to the test data read from the trial writing region and the outer peripheral side laser output set according to the test data read from the outer peripheral region are deleted from the memory when the disk is replaced.

Inaba discloses (see abstract) clearing the content of a memory when a disk is replaced (whenever a door is opened) in order to free unnecessary data from memory and to obtain sufficient memory space. It would have been obvious to one of ordinary skill in the art at the time of invention by the applicant to have deleted the inner and outer peripheral side laser outputs of Miyata, Lee (or Kim) & Horiguchi from the memory when the disk is replaced, as suggested by Inaba. The motivation would have been to free unnecessary data from memory and to obtain sufficient memory space.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyata, Lee (or Kim) & Horiguchi as applied to claim 6 above, and further in view of Toyooka et al. (hereafter Toyooka) (US 4,788,672).

For a description of Miyata, Lee (or Kim) & Horiguchi, see the rejection above. However, it is not disclosed that the inner peripheral side laser output set according to the test data read from the trial writing region and the outer peripheral side laser output set according to

the test data read from the outer peripheral region are deleted from the memory when a predetermined time elapses after the end of a recording operation.

Toyooka discloses (see abstract) erasing unnecessary data during a period of time when the optical disc memory is not accessed, in order to free unnecessary data from memory and to obtain sufficient memory space. It would have been obvious to one of ordinary skill in the art at the time of invention by the applicant to have deleted the inner and outer peripheral side laser outputs of Miyata, Lee (or Kim) & Horiguchi from the memory when a predetermined time elapses, as suggested by Toyooka. The motivation would have been to free unnecessary data from memory and obtain sufficient memory space.

Response to Arguments

7. Applicant's arguments filed October 12, 2004 have been fully considered but they are not persuasive.

8. In regard to page 6, last two lines of paragraph 1, the applicants argue that any of the cited references neither disclose nor suggest the feature of claim 1 "said outer peripheral region is disposed outside the lead-out region". Note that the examiner has acknowledged on the Office Action of August 18, 2004 that the primary reference, Miyata, "does not disclose the presence of a buffer region, a lead-in region, and a **lead-out region**" (see first two lines of page 3). Therefore, the examiner also acknowledged that Miyata, when viewed alone, is silent, or does not explicitly disclose that "said outer peripheral region is disposed outside the lead-out region", since the claimed lead-out region is not explicitly disclosed. However, the examiner disagrees that claim 1 is allowable over the cited references in combination for the following reasons. First, it should be noted that one cannot show nonobviousness by attacking references individually

where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Second, the secondary references, Lee or Kim, inherently disclose an outer peripheral region disposed outside a lead-out region. Figure 4 of Lee (or figure 4A of Kim) show different regions of an optical disc arranged from an inner peripheral region to an outer peripheral region. The examiner reads the “outer peripheral region” to correspond to an area outside the lead-out area of Lee (figure 4) or Kim (figure 4A). Finally, the examiner has noted in the Office Action of August 18, 2004 that “[i]t would have been obvious to one of ordinary skill in the art at the time of invention by the applicant to have added the trial, buffer, lead-in, program, and lead-out regions of Lee (or Kim) to the disk of Miyata” (see paragraph 3, page 2). This combination of references would at least make it obvious to have an outer peripheral region being disposed outside the lead-out region as claimed.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Vincent Agustin whose telephone number is 703-305-8980. The examiner can normally be reached on Monday-Friday 9:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on 703-305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peter Vincent Agustin
Art Unit 2652



BRIAN E. MILLER
PRIMARY EXAMINER